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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,041	07/11/2001	E. Ray Carter	2025	9899
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H. GORDON SHIELDS 7830 NORTH 23RD AVENUE PHOENIX, AZ 85021		EXAMINER SOOHOO, TONY GLEN		
		ART UNIT PAPER NUMBER		
		1723		

DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/903,041

Applicant(s)

CARTER, E. RAY

Examiner

Tony G Soohoo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 29-30, 32-33 is/are rejected.
- 7) ☒ Claim(s) 28, 30-31 and 34-36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***Claim remarks***

1. The recitation of a "motor... for rotating the means for holding a spray can... at a relatively low RPM of between about thirty five and sixty RPM" has not invoked 35 USC 112, 6<sup>th</sup> paragraph with regards to structural means plus function.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 9-11, 14, 21, 24-26, 29, 32, 33, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Roepke Sr. 5439287.

With regards to claim 1, Roepke shows a base 120, figures 7-8, a panel sides 118, 116, figure 7 or the lower curving panels of 60, and a means for holding a spray paint can via the upper engaging wings of 112, 114.

With regards to claim 9, Roepke shows a means 112, 114, for holding a can of spray paint, a motor in the drill 68, and means for supporting the means for holding the spray paint can and the motor, in particular, a handle of the drill.

With regards to the rotation, it is noted that the container would oscillate about the offset shaft of the c-clamp at 62 while it is additionally rotated about a circular path

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caused by the rotation of the shaft portion at 64, 70 which is held by the rotating chuck of the drill driver. Also, column 3 lines 60-63 state" the can will not only be oscillate [sic] by the motion of the device but will also rotate at a slow rate of speed within the C-shaped bracket that will cause better mixing of the paint and pigment". With regards to the rotation speed in RPM, whereas the claim points out the language of a "motor" and not "motor means for providing an ... RPM", applicant has not invoked 35 USC 112, 6<sup>th</sup> paragraph and does not claim a positive structural distinction to the claimed limitation of the motor. Nonetheless, it is also noted that the motor as shown by the reference is fully capable of performing such a range of RPM in response to the amount of power it is supplied to the motor or otherwise would have been obvious to modify the motor to produce such speeds in order to perfect the amount of kinetic energy introduced into the system for agitating the contents of the container whereas it is old and well known in the art of agitation that the speed of rotation of a container is a direct variable in producing the rate of agitation of the contents in the container.

4. Claims 1-7, 9-15, 21, 24-26, and 22-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rosenblatt 3291454.

Note: With regard an anticipation the claims note above, the intended use of holding and shaking a paint can, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

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With regards to claim 2, note that the motor 16 has a motor housing secured to the base via the panel 14, which covers the rotor and stator of the motor, for rotating a container can 22 about the rotation axis along 18.

With regards to claims 5 and 12, note the shaft ring 18 forming a rotation axis.

With regards to claims 6 and 13 note that the panel 14 has an annular recess for allowing the drive shaft pass there through.

With regards to claim 7 note that the clamp is a u shape with a base and two extending arms. This u-shaped platform clamp structure maybe defined as a back panel (the base of the U), a top panel (one arm of the U), and a bottom panel (the other arm of the U). It is further noted that the U-shaped clamp spins about the back panel portion thereby the arms of the U may define a top and bottom orientation of the top and bottom panels.

With regards to claims 24-26 note that the clamp is a u shape with a base and two extending arms. This u-shaped platform clamp structure maybe defined as a element means having a back panel (the base of the U) with 1<sup>st</sup> end area and 2<sup>nd</sup> end area, and two spring arms attached at each area. It is further noted that the U-shaped clamp spins about the back panel portion thereby the arms of the U may define a top and bottom orientation of the top and bottom panels.

With regards to the rotation speed in RPM, whereas the claim points out the language of a "motor" and not "motor means for providing an ... RPM", applicant has not invoked 35 USC 112, 6<sup>th</sup> paragraph and does not claim a positive structural distinction to the claimed limitation of the motor. Nonetheless, it is also noted that the

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motor as shown by the reference is fully capable of performing such a range of RPM in response to the amount of power it is supplied to the motor

Alternately, should the feature of the motor production of RPM of the shaft (claim 22) or paint (claims 1 and 9) is deemed to be considered as inclusive of a structural scope and limitation that the electric motor be of the type to produce 35-60 RPM of the shaft, it is noted that the Rosenblat teaches 5-20 RPM.

It is then noted, it is commonly known in the art of agitation and mixing that the amount of cycles of per unit time of oscillation of a container is a direct variable to the amount of kinetic energy supplied to produce an agitation effect by transfer of kinetic energy to the fluids in the container and increase in kinetic energy provide to the container motion in during would cause an increase in the rate of homogenization of the fluids.

It is also known that the change in rate of RPM in a motor is provided by either an increase in fuel energy to the rotor/stator drive or a change in gearing in the transmission to the drive shaft, such knowledge is commonly well known and within the skill of a person having ordinary skill in the art.

Whereas it is known to be desirable to increase the amount of RPM of the shaking effect so that the contents of the mixture is mixed faster, and whereby such a change of RPM to the motor is well within the skill of a person having ordinary skill in the art by changing a size of a gear or power input, since such a modification would have involved a mere change in the size of a component, ( A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ

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237 (CCPA 1955).) it is deemed that it would have been obvious to one of ordinary skill in the art to modify the size of the motor, it's gearing ratio, or power amperage provided in order to provide a physical RPM of the motor to a 35-60 RPM such that the mixing time is shortened. It is noted that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. In this case the motor produces 5-20 RPM, the desire for motor property of producing 35-60 RPM is desirable for an decrease in mixing time and discovering the optimum or workable ranges of the values of 35-60 RPM involves only routine skill in the art

5. Claims 7-8, 15-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenblatt 3291454 in view of Blume et al 4125335.

The Rosenblatt reference discloses all of the recited subject matter as defined within the scope of the claims with the exception of the clamping means having a top panel and bottom panel for holding containers of different lengths, further including springs in each of the top and bottom panel portion areas.

The reference to Blume et al (Blume) teaches that a clamp system having a back panel which includes a intermediate U-shaped clamp to hold the sides of the container and an upper and lower end plates with a spring clamp section for holding the top and bottom of the container whereby the upper and lower spring clamps may accommodate for slight differences in the sizes of the container length in height.

In view of the teaching of the Blume reference that additional panels for the top and bottom ends of the container is provided with additional spring attachment means for the better holding of the container from both the sides and the top and bottom, it is deemed that it would have been obvious to one of ordinary skill in the art to substitute for the single clamp of Rosenblatt with the plural top and bottom end spring clamps and side clamps of Blume et al so that the container may be more securely held by the support means when the container is agitated.

6. Claims 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenblatt 3291454 in view of Sterrenberg 4318622.

The Rosenblatt reference discloses all of the recited subject matter as defined within the scope of the claims with the exception of the clamping means having a strap to hold the container.

The reference to Sterrenberg teaches that a clamp system having a two U shaped arms 93 and includes a strap 61, 62 for further securing the container to be shaken.

In view of the teaching of the Sterrenberg reference that additional straps for the top and bottom ends of the container may be provided for the better holding of the container, it is deemed that it would have been obvious to one of ordinary skill in the art to substitute for the single clamp of Rosenblatt with the U-shaped arms and straps of Sterrenberg so that the container may be more securely held by the support means when the container is agitated.



***Allowable Subject Matter***

7. Claims 28, 30-31, 34-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

8. Applicant's arguments filed 2/18/2003 have been fully considered but they are not persuasive.

Applicant argues in the response of 7/28/03 and previous response 2/18/2003 that the Roepke reference does not rotate the can but oscillates the can, and furthermore the hand drill would not be able to rotate the can at the low RPM of 35-60RPM as claimed, and moreover that the Roepke does not include a panel extending upward from a base and connected to the panel.

As pointed out in the rejection above, the Roepke reference shows all of the recited elements as recited and also would oscillate about the offset shaft section and also rotate the about the axis of the chucked shaft held within the drill driver. Although the motion of the can itself can does not spin about the longitudinal axis of drive shaft directly around the drive shaft axis, it does however rotate about an axis caused by the offset of the drive shaft axis which is held for rotation by the drill driver. Also, another rotation is achieved by an unexpected slippage of the can to the holder, see column 3, line s60-63. Since the claims do not require or differentiate such a motion of the axis of

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rotation of the can as spinning about itself in rotation, the movement by the Roepke reference is deemed anticipating the scope of the claim language.

With regards to the speed of rotation, the claims applicant has not invoked 35 USC 112, 6<sup>th</sup> paragraph and does not claim a positive structural distinction to the claimed limitation of the motor. Nonetheless, it is also noted that the motor as shown by the reference is fully capable of performing such a range of RPM in response to the amount of power it is supplied to the motor, or otherwise additionally, would have been obvious to modify the motor to produce such speeds in order to perfect the amount of kinetic energy introduced into the system for agitating the contents of the container whereas it is old and well known in the art of agitation that the speed of rotation of a container is a direct variable in producing the rate of agitation of the contents in the container.

Applicant argues that with regards to the Rosenblatt reference, the reference does not teach the recited RPM operation of 35-60 RPM, in addition the intended use is for rotating insulin, not paint. It is noted that the claims are apparatus claims and are not method of use claims. Also, the container itself is not positively claimed as an element of the invention, and thus details to a paint can provide little patentable distinction to the scope of the claim. Thus is it deemed that applicant's arguments to the intended use of the instant invention in contrast to that that of the device of Rosenblatt is unpersuasive. With regards to the speed of rotation, the claims applicant has not invoked 35 USC 112, 6<sup>th</sup> paragraph and does not claim a positive structural distinction to the claimed limitation of the motor. Nonetheless, it is also noted that the

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motor as shown by the reference is fully capable of performing such a range of RPM in response to the amount of power it is supplied to the motor, or otherwise additionally, would have been obvious to modify the motor to produce such speeds in order to perfect the amount of kinetic energy introduced into the system for agitating the contents of the container whereas it is old and well known in the art of agitation that the speed of rotation of a container is a direct variable in producing the rate of agitation of the contents in the container.

With regards to the argument that the references are "all for agitating paint cans and not rotating them... none of the cited references relate to rotating a can of spray paint". As noted above with regards to Roepke, the reference in figures 3-8 does show a rotating of a can rotating about an axis of the drill drive chuck which the motion. As noted above to Rosenblatt, the reference shows a rotation of a container 22 about a drive shaft 18, details to the intended use of a spray can does is not required as a positive element of the claimed structure and thus is immaterial to the patentable distinction and scope of the claimed invention with that of the prior art as applied.

### ***Conclusion***

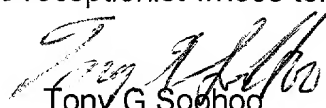
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony G Soohoo whose telephone number is (703) 308-2882. The examiner can normally be reached on 7:00 AM - 5:00 PM, Tues. - Fri.. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Tony G Soohoo  
Primary Examiner  
Art Unit 1723

tgs.